

**REMARKS**

Claims 1-21 are pending in the application. Claims 1-21 are rejected by the Examiner. The Examiner's rejections are addressed below in substantially the same order as in the office action.

**REJECTIONS UNDER 35 USC § 102****1. U.S. 4,688,640**

The Examiner rejected claims 1-21 under 35 USC § 102(b) as being anticipated by (U.S. 4,688,640). The Examiner contends that US'640 discloses a method that includes a method for performing a downhole operation in a wellbore, comprising: (a) conveying a tool having a first module 40 proximally connected to a second module 51 into the wellbore, the first module having a selectively adjustable positioning device 55; and (b) actuating the positioning device to selectively position the first module radially relative to a reference point 33, the first module's relative position being different from the relative position of the second module. Applicant responds as follows:

**A. U.S. 4,688,640 - Independent Claims 1 and 12**

With respect to amended independent claims 1 and 12, Applicant submits that US '640 does not teach or suggest a module that is operable in at least two positions. Rather, US '640 discloses a tool that operates in one and only one position, i.e., perforating charges that are specifically intended to be positioned against a tubing wall to perforate the tubing wall without perforating an adjacent tubular wall. Thus, US '640 teaches away from the present invention, because, in part, it teaches a positioning device that positions the tool (i.e., perforating charge) in only one operating position. If the disclosed positioning device does not position the charges against the casing wall, then the perforating operation may fail. In contrast, claims 1 and 12 recite a module that is operable in at least two positions. Thus, claims 1 and 12 as amended are not anticipated or obviated by US '640.

**B. U.S. 4,688,640 - Dependent Claims 2-11 and 13-21**

With respect to the dependent claims, Applicant is unable to specifically address the Examiner's rejections because the Examiner has not identified what elements in US

'640 teach the recitations in the dependent claims. Initially, Applicant notes that the independent claims 1 and 12 are believed to be in condition for allowance. Thus, the dependent claims are allowable on at least those grounds. Other grounds are discussed below for selected claims.

With respect to claims 3 and 17, US '680 does not disclose or suggest controlling the positioning device with a controller.

With respect to claim 4, US '680 does not disclose or suggest adjusting the positioning device in response to one of: (i) preprogrammed data; (ii) a dynamically updated model; and (iii) data signals provided by a sensor coupled to the controller.

With respect to claims 6 and 14, US '680 does not disclose or suggest a measurement tool in the first module.

With respect to claims 7 and 15, US '680 does not disclose or suggest moving the first module along the wellbore while operating the measurement tool.

With respect to claims 8, 9 and 19, US '680 does not disclose or suggest adjusting the position of the first module while the measurement tool is being operated.

With respect to claim 10, US '680 does not disclose or suggest operating the measurement tool in a first portion of the wellbore; moving the measurement tool to a second portion of the wellbore; actuating the positioning device to position the first module in a selected position at the second portion of the wellbore; and operating the measurement tool in the second portion of the wellbore.

With respect to claim 21, US '680 does not disclose or suggest a positioning device adapted to disengage a measurement tool disposed in the first module from a wall of the wellbore.

## **2. EP 0313374**

The Examiner rejected Claims 1-21 under 35 USC 102(b) as being anticipated by (EP 0313374). The Examiner contends that EP'374 discloses a method that included a method for performing a downhole operation in a wellbore, comprising: (a) conveying a tool having a first module 50 proximally connected to a second module 51 into the wellbore, the first module having a selectively adjustable positioning device; and (b) actuating the positioning device to selectively position the first module radially relative to a reference point, the first module's relative position being different from the relative position of the second module.

### **A. EP 0313374 - Independent Claims 1 and 12**

With respect to amended independent claims 1 and 12, Applicant submits that EP '374 does not teach or suggest a module that is operable in at least two positions. Rather, EP '374 discloses a logging tool that must be pressed against the wellbore wall. Like, US '640, the tool of EP '374 operates when in only one specific position. In contrast, claims 1 and 12 recite a module that is operable in at least two positions. Thus, claims 1 and 12 as amended are not anticipated or obviated by EP '374.

**B. EP 0313374 - Dependent Claims 2-11 and 13-21**

With respect to the dependent claims, the Examiner contends that EP '375 teaches the a measurement tool; and an apparatus comprising: (a) an umbilical 10; (b) a first module 50 conveyed on the umbilical; (c) a second module 51 conveyed on the umbilical proximally to the first module; and (c) a positioning device associated with the first module, the positioning device being adapted to selectively adjust the position off the associated module relative to the second module. Aside the measurement tool, the Applicant is unable to locate which elements in EP '374 are contended by the Examiner to be in the dependent claims. Initially, Applicant believes that the dependent claims are allowable because their base claim is believed to define over the prior art of record. Additionally, to Applicant's reading, EP '374 is not anticipatory or obviating art for at least the following reasons:

With respect to claims 3 and 17, EP '374 does not disclose or suggest controlling the positioning device with a controller.

With respect to claim 4, EP '374 does not disclose or suggest adjusting the positioning device in response to one of: (i) preprogrammed data; (ii) a dynamically updated model; and (iii) data signals provided by a sensor coupled to the controller.

With respect to claims 7 and 15, EP '374 does not disclose or suggest moving the first module along the wellbore while operating the measurement tool.

With respect to claims 8, 9 and 19, EP '374 does not disclose or suggest adjusting the position of the first module while the measurement tool is being operated.

With respect to claim 10, EP '374 does not disclose or suggest operating the measurement tool in a first portion of the wellbore; moving the measurement tool to a second portion of the wellbore; actuating the positioning device to position the first module in a selected

position at the second portion of the wellbore; and operating the measurement tool in the second portion of the wellbore.


With respect to claim 21, EP '374 does not disclose or suggest a positioning device adapted to disengage a measurement tool disposed in the first module from a wall of the wellbore.

**CONCLUSION**

For all the foregoing reasons, Applicant submits that the application is in a condition for allowance. No fee is believed due for this paper. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0429 (584-30697-US).

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I do hereby certify that this correspondence is being transmitted via facsimile, to the Commissioner for Patents, Examiner, Zakiya Nicole Walker, facsimile no. (571) 273-8300, on this 22nd day of November 2005.

  
Margaret A. Pruitt